

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WEN-SUNG TSAI

MAILED

DEC - 9 2004

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/683,729

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on October 22, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

The final rejection (Paper No. 9) filed April 11, 2003 indicated that claims 6, 7, 9, 10 and 12-14 were rejected. In the appeal brief (Paper No. 11, page 2) filed December 10, 2003, the appellants have appealed claims 6, 7, 9, 10, 12 and 14. There is no indication that the appeal of claim 13 was withdrawn. Yet, this claim was omitted from the appendix of the appeal

brief. This causes confusion as to the status of claim 13. In addition, if claim 13 is to be appealed, the appendix of claims would be defective, since claim 13 is missing.

In addition, on July 2, 2004, the examiner responded (Paper No. 14) to the reply brief (Paper No. 13) filed on April 23, 2004. The response contains additional arguments which is improper. See § 1208.03 of the Manual of Patent Examining Procedure (8th ed., Aug. 2001) which states:

[A]ppellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer. . . . The primary must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02.

Accordingly, it is

ORDERED that this application be returned to the examiner for: 1) indicate whether or not the appeal of claim 13 is withdrawn; 2) if the appeal of claim 13 is not withdrawn, submit a corrected appendix to the appeal brief (Paper No. 11), or the issuance by the examiner of a supplemental examiner's answer to officially correct the existing defective appendix; 3) proper response to the reply brief filed on April 23, 2004; and 4) for such further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

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